

REMARKS/ARGUMENTS

I. Amendments to the Claims

Claims 1, 4-11 and 13-15 are pending in this Application. Claims 2-3, 12 and 16-39 have been canceled. Claim 1 has been newly amended. Claims 4-11 and 13-15 were previously amended. No new matter has been incorporated by these amendments.

Claim 1, page 2, has been amended by deleting the phrase "an ocular COX-2 mediated disorder" from the preamble. The phrase "blepharitis, post-operative inflammation and pain from corneal transplant surgery, endophthalmitis, episcleritis, keratitis, keratoconjunctivitis, keratoconjunctivitis sicca, post-operative inflammation and pain from lens implantation surgery, Mooren's ulcer and post-operative inflammation and pain from retinal detachment" was inserted immediately after the word "treating" in Claim 1.

Support for these amendments can be found on page 12, line 96; page 14, line 24, page 29, line 33, and page 96, line 12 of the original filed Application.

Also in Claim 1, the phrase, "**the COX-2 inhibitor**" was deleted immediately following the words, "prodrug thereof," and immediately preceding the word "selected".

II. 35 U.S.C. § 112 Rejection - first paragraph

A. **Claims 1, 4-11, and 13-15 have been amended and are fully enabled by the specification.**

Claims 1, 4-11, and 13-15 have been rejected under 35 U.S.C. 112, first paragraph. The Office states that while

claims 1, 4-11, and 13-15 are enabled for the ocular COX-2 mediated disorders of blepharitis, post-operative inflammation and pain from corneal transplant surgery, endophthalmitis, episcleritis, keratitis, keratoconjunctivitis, keratoconjunctivitis sicca, post-operative inflammation and pain from lens implantation surgery, Mooren's ulcer and post-operative inflammation and pain from retinal detachment surgery, they are not enabled for other types of ocular COX-2 mediated disorders.

The Office has cited *In re Wands*, and the eight Wands factors used to determine whether undue experimentation is necessary in the present Application.

The Applicants acknowledge and appreciate the Office's careful analysis of the present Application in view of the Wands factors. In response, while not acquiescing to the Office's analysis, the Applicants have amended Claim 1 in order to advance the prosecution of the Application and the allowance of the claims. The claims are now drawn to therapeutic methods for treating and preventing the following COX-2 mediated disorders: blepharitis, post-operative inflammation and pain from corneal transplant surgery, endophthalmitis, episcleritis, keratitis, keratoconjunctivitis, keratoconjunctivitis sicca, post-operative inflammation and pain from lens implantation surgery, Mooren's ulcer and post-operative inflammation and pain from retinal detachment surgery.

Support for amendments to claim 1 can be found on page 14, line 24; page 29, line 33; and page 96, line 12. Claims 4-11, and 12-15 depend from claim 1.

Claims 1, 4-11, and 13-15 now stand ready for allowance.

B. Rejection of Claims 17-39 under 35 U.S.C. 112, first paragraph, is moot because Claims 17-39 have been canceled.

Claims 17-39 have been rejected under 35 U.S.C. 112, first paragraph, because, according to the Office, the specification, while being enabling for the treatment of the ocular COX-2 mediated disorders of blepharitis, post-operative inflammation and pain from corneal transplant surgery, endophthalmitis, episcleritis, keratitis, keratoconjunctivitis, keratoconjunctivitis sicca, post-operative inflammation and pain from lens implantation surgery, Mooren's ulcer and post-operative inflammation and pain from retinal detachment surgery, does not reasonable provide enablement for prevention of these ocular COX-2 mediated disorders.

Claims 17-39 have been canceled without prejudice, and therefore the rejection of these claims is believed to be moot.

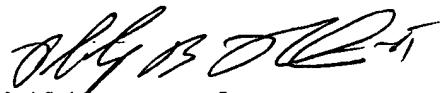
### **III. Obviousness-type Double Patenting Rejection**

Claims 1-39 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 40 of copending Application No. 09/904,098. As acknowledged by the Office, the alleged conflicting claims have not been allowed. Applicants, therefore, will address the merits of the obviousness-type double patenting rejection when or if copending Application No. 09/904,098 is allowed.

**IV. Conclusion**

If the Examiner believes a telephonic interview with Applicant's representative would aid in the prosecution of this application, the Examiner is cordially invited to contact Applicant's representative at the below listed number.

Respectfully submitted,



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